



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,415	11/07/2001	Mitchell D. Eggers	PW 083022 278802	9374

7590 02/15/2006

Pillsbury Winthrop LLP
Intellectual Property Group
Suite 1800
101 W. Broadway
San Diego, CA 92101-8219

EXAMINER

HARRELL, ROBERT B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,415

Applicant(s)

EGGERS, MITCHELL D.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: see attached Office Action.

Art Unit: 2142

1. Claims 1-53 remain for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. There is within the scope of the defined invention matters directed to a remote client over a network not covered in the Title.
3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 41-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since such reads on (encompass) printed matter and/or carrier waves as such lack being embodied on a computer readable storage medium (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106).

6. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 41-55 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear because "adapted to" (within newly added/amended text) language suggests or makes optional but does not require steps to be performed nor limit a claim to a particular structure and thus does not limit the scope of a claim or claim limitation (see MPEP 2106 (II(C))). Therefore, the claim scope is open ended without meets and bounds and thus indefinite.

8. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969);

Art Unit: 2142

In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

9. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

10. **Claims 1-53, of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 63-72, 76-80, 82, 83, 86-93, 102-109, and 113-115 of United States Patent Application 10/005,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/005,529 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/005,529.

11. **Claims 1-53, of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-40 and 58-69 of United States Patent Application 10/007,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/007,355 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/007,355.

12. **Claims 1-53, of this United States Application, are rejected under the judicially created doctrine of obviousness-type double patenting** as being unpatentable over claims 1-64 and 58-86-114 of United States Patent Application 10/150,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10/150,771 application claims encompasses the claims of this United States Application by the removal of a client over a network which this current United States Patent Application contains therein the defined invention and thus resides in the scope of 10/150,771.

13. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the each reference is*

Art Unit: 2142

cited and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

15. **Claims 1-53 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1).

16. The rejection, and grounds for rejection, under 35 U.S.C. 102(e) as presented in examiner's prior Office Action mailed 13 June 2005, are hereby maintained and incorporated in this Office Action by reference.

17. The applicant argued in his 13 December 2005 response by stating in substance that:

- a) Milosavljevic does not teach nor suggest a plurality of discrete sample nodes but instead teaches an array of probes and a sample that is applied to the array of probes. **However**, as stated by Milosavljevic "the probes in each test site differ from the probes in other test sites in a known manner". Since they "differ" they are discrete;
- b) Milosavljevic does not teach nor suggest selecting, identification, and retrieving sample nodes nor the performing a selected assay for a selected sample node. **However**, Milosavljevic taught means for receiving a request (e.g., see figure 2 (205)) from a remote client (e.g., see figure 1 (105)), said request containing identification information related to performing a selected analysis from selected ones of said plurality of discrete sample nodes (e.g., see figure 2 (205) and/or 4 (405) and [0012]);
- c) the microarray taught in Milosavljevic is described as an array of test sites separate from the sample and therefor the microarray cannot reasonably be construed as a plurality of sample nodes. Even assigning arguendo, such construction to the microarray, Milosavljevic still does not teach or suggest each of a plurality of sample nodes being irremovably attached to a corresponding sample carrier; nor is such taught per claims 41 and 46. **However**, Milosavljevic taught a sample archive (e.g., see Title) comprising a plurality of sample carriers (e.g., see figure 5 and 5A); each of said plurality of sample carriers configured to support a plurality of discrete sample nodes (e.g., see [0094] and/or [0098]) to [0103]. Also taught was a processor responsive to said means for receiving and operative to retrieve selected ones of said data records from said

Art Unit: 2142

database (e.g., see [0098] to [0103] note “When a particular sample is requested, automated equipment such as robotics may be used to select and obtain the corresponding DNA sample and provide the sample to the microarray for interrogation.” in [0100]) along with a sample retrieval apparatus responsive to said processor and operative to retrieve said selected ones of said plurality of discrete sample nodes [0098] to [0103]. It is noted that the cards were also samples and that while figure 5 showed only one array, the addition of more was an anticipated expansion to that of Milosavljevic;

d) the delivery of test results anticipated the packaging of sample nodes for shipping to a remote client is erroneous. *However*, per paragraph [0095] of Milosavljevic taught shipping and as indicated in examiner's prior Office action, since the biological matter was shipped to the test site, such return shipping was anticipated since shipping was mentioned within the reference.

18. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. *Claims 1-53 are rejected under 35 U.S.C. 103(a)* as being unpatentable over Milosavljevic et al. (United States Patent Application Publication US 2004/0098204A1) in view of Brignac, JR et al. (United States Patent Application Publication US 2004/0014228A1).

20. The rejection, and grounds for rejection, under 35 U.S.C. 103(a) as presented in examiner's prior Office Action mailed 13 June 2005, are hereby maintained and incorporated in this Office Action by reference.

21. The applicant argued in his 13 December 2005 response by stating in substance that:

a) Brignac teaches retrieving discrete sample nodes that carry discrete sample by rather describes the extraction of portions of a biological specimen from a substrate and thus does not cure the deficiencies of Milosavljevic. *However*, Brignac (e.g., see figures 1-7) taught a mechanical sample carrier locator and remover (e.g., see figure 4) with clipping tool (e.g., see figure 4 (52)), and optical sensors (e.g., (0018))) as called for, and suggested by Milosavljevic and thus robotically selecting samples, in the manner claimed by the applicant of this United States Patent Application, would have been obvious for the reasons set forth in examiner's prior Office Action.


22. *A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).*

Art Unit: 2142

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142